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10/554,009

10/21/2005

Teppo Kojo

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EXAMINER

JARRETT, RYAN A

ART UNIT

PAPER NUMBER

2121

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/554,009	<b>Applicant(s)</b> KOJO, TEPP0	
	<b>Examiner</b> Ryan A. Jarrett	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/21/05</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

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The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “wherein if the splice location is too close to the surface the machine reel diameter instruction is *increased* such that the splice location is acceptable” (emphasis added) of claim 28 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Currently, Fig. 4 #27 depicts “*Reducing* the diameter of the machine reel” (emphasis added) when the splice is too close to the surface. There is a discrepancy between claim 28 and Fig. 4 #27. It is not clear which one is correct.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities:

The first citation in paragraph [0008] should be placed in parenthesis.

There is a discrepancy between paragraph [0021] and claim 28. Paragraph [0021] states, “If the splice is too close to the surface in the block 27, the machine reel diameter is reduced”. However, claim 28 recites that the machine reel diameter is increased in such a situation. Clarification is required.

Appropriate correction is required.

***Claim Objections***

Claim 20 is objected to because of the following informalities:

In claim 20 line 2, “instructionto” should be changed to “instruction to”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 27, it is unclear where these exact steps are taught in the original disclosure filed 04/22/04. It appears that Fig. 4 #23 corresponds somewhat to claim 27, but not exactly.

Regarding claim 28, the original disclosure filed 04/22/04 does not disclose “wherein if the splice location is too close to the surface the machine reel diameter instruction is *increased* such that the splice location is acceptable” (emphasis added). Rather, the original disclosure teaches *reducing* the machine reel diameter instruction in such a situation (see Fig. 4 #27 and [0021] of specification).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 10-12, the phrase "calculating/optimizing" recited in numerous places renders the claims indefinite because it is unclear what the intended scope of the phrase is. It appears that this term should be changed to "calculating and optimizing".

It is noted that the original claims were pre-amended in order to eliminate the "characterized in that" terminology, which is not consistent with U.S. practice. However, there are still some remnants of the old "characterized in that" terminology in claim 10 that need to be corrected. Examples follow.

Regarding claim 10, the phrase "and the amount of broke" beginning on line 10 is disjointed with respect to the phrase "determining the diameter" beginning on line 8. Correction is required.

Regarding claim 10 line 11, the phrase "that, in the method" is disjointed with respect to the rest of the claim. Correction is required.

Regarding claim 10 line 14, the phrase "and that" is disjointed with respect to the rest of the claim. Correction is required.

Claim 13 depends from claim 10 and incorporates the same deficiency.

Claim 14 recites the limitation "the number" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 10 previously recites only "a splice", i.e., a single splice.

Claim 15 recites the limitation "are taken into account in the method". This type of phrase does not conform to accepted U.S. practice. It is unclear how the various actions are "taken into account in the method".

Claim 16 recites the limitation "by means of the method". This type of phrase does not conform to accepted U.S. practice. It is unclear how the action is performed "by means of the method".

Claims 17 and 18 depend from claim 10 and incorporate the same deficiency.



***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bush et al. US 6,873,879. For example, Bush et al. teaches:

**10. A method for calculating/optimizing the diameter of a paper or board web machine reel, in which a web is wound in a paper or board machine into machine reels on a reel-up, which are run on a slitter-winder to form customer rolls, whose desired diameter and width are determined according to customer need, and in which a continuous-trimming running mode is used in which desired amount of web is run into a machine reel and, when needed, splicing is performed on the slitter-winder to produce customer rolls with a desired diameter size (e.g., Fig. 1), the method comprising the steps of:**

**determining the diameter of the machine reel to be wound on the paper or board machine on the basis of restrictions set by the customer on the location of a splice in the customer roll (e.g., col. 1 lines 46-50, col. 2 lines 43-57, col. 4 line 54 – col. 5 line 7, col. 6 lines 37-67) and the amount of broke being produced from the machine reel is optimized (e.g., col. 2 lines 25-32), that, in the method, information about the customer rolls to be slit is obtained from a production control system for calculating/optimizing a machine reel**

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**diameter instruction for the purpose of optimizing the diameter of the next machine reel (e.g., Fig. 3, col. 3 lines 48-53), and that the calculated/optimized machine reel diameter instruction is set in a control system of the reel-up (e.g., col. 2 lines 15-22, col. 2 lines 43-45, col. 2 lines 53-55); and**

**forming a machine reel on the paper or board machine according to the machine reel diameter instruction (e.g., col. 2 lines 7-22).**

**11. The method of claim 10 wherein the calculated/optimized machine reel diameter instruction is fed manually to the control system of the reel-up (e.g., col. 2 lines 53-55).**

**12. The method of claim 10 wherein the calculated/optimized machine reel diameter instruction is transmitted automatically to the control system of the reel-up (e.g., col. 2 lines 15-22, col. 2 lines 43-45).**

**13. The method of claim 10 wherein the restrictions on the splice location are set according to each individual paper grade, printing house and/or order (e.g., col. 3 lines 48-53).**

**14. The method of claim 10 wherein the number and the location of the splices to be placed in customer rolls (e.g., col. 1 lines 46-50, col. 2 lines 43-57, col. 4 line 54 – col. 5 line 7, col. 6 lines 37-67) and the resultant machine reel broke (e.g., col. 2 lines 25-32), caused because of the joining of machine reels to one another, are optimized.**

**15. The method of claim 10, wherein undersize machine reels produced as a result of web breaks on the paper or board machine and the optimization of the location of the**

**splice used for joining them are taken into account in the method** (e.g., col. 1 lines 46-50, col. 2 lines 43-57, col. 4 line 54 – col. 5 line 7, col. 6 lines 37-67).

**16. The method of claim 10 wherein the slitting order of machine reels is changed by means of the method** (e.g., col. 6 lines 52-67).

**17. The method of claim 10, wherein the method is applied as a stand-alone system in connection with a slitter-winder and a machine reel-up** (e.g., Figs. 1-2).

**18. The method of claim 10, wherein the method is applied as a part of a production control system of the paper or board machine** (e.g., col. 3 lines 48-53, Fig. 3).

**19. A method of forming customer rolls on a slitter-winder from machine reels formed on a paper or board machine having a reel-up, the method comprising the steps of:**

**winding a first machine reel of a paper or board web on the paper or board machine reel-up, the first machine reel being formed to have a first diameter** (e.g., Fig. 1, col. 1 lines 46-50);

**winding a second machine reel of a paper or board web on the paper or board machine reel-up, the second machine reel being formed to have a second diameter** (e.g., Fig. 1, col. 1 lines 46-50); **and**

**running the first machine reel and the second machine reel on the slitter winder, and splicing the webs of the two machine reels together on the slitter winder, the spliced-together webs being run into a plurality of customer rolls** (e.g., Fig. 1), **wherein the customer rolls are formed to have a desired diameter and width which are determined**

**according to a customer's need (e.g., Fig. 3, col. 3 lines 48-52), and wherein one of the first and second reel is wound to a machine reel diameter instruction, said machine reel diameter instruction being determined on the basis of restrictions set on the location of a splice in the customer roll (e.g., col. 1 lines 46-50, col. 2 lines 43-57, col. 4 line 54 – col. 5 line 7, col. 6 lines 37-67), wherein information about the customer rolls to be slit is obtained from a production control system for determining the machine reel diameter instruction (e.g., Fig. 3, col. 3 lines 48-53), and the machine reel diameter instruction is set in a control system of the reel-up (e.g., col. 2 lines 15-22, col. 2 lines 43-45, col. 2 lines 53-55).**

**20. The method of claim 19 further comprising the step of manually feeding the determined machine reel diameter instruction to the control system of the reel-up (e.g., col. 2 lines 53-55).**

**21. The method of claim 19 wherein the determined machine reel diameter instruction is transmitted automatically to the control system of the reel-up (e.g., col. 2 lines 15-22, col. 2 lines 43-45).**

**22. The method of claim 19 wherein the restrictions on the splice location are set according to each individual paper grade, printing house and/or order (e.g., col. 3 lines 48-53).**

**23. The method of claim 19, wherein one of the first machine reel and the second machine reel is an undersize machine reel produced as a result of a web break on the paper or board machine (e.g., col. 1 lines 46-50, col. 2 lines 43-57, col. 4 line 54 – col. 5 line 7, col. 6 lines 37-67).**

**24. The method of claim 19 further comprising the step of changing the order of the first and second machine reels being run on the slitter winder (e.g., col. 6 lines 52-67).**

**25. The method of claim 19, wherein the method is applied as a stand-alone system in connection with a slitter-winder and a machine reel-up (e.g., Figs. 1-2).**

**26. The method of claim 19, wherein the method is applied as a part of a production control system of the paper or board machine (e.g., col. 3 lines 48-53, Fig. 3).**

***Allowable Subject Matter***

Claims 27 and 28 would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. However, it is not entirely clear to the examiner how these claims should be rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan A. Jarrett/  
Primary Examiner, Art Unit 2121

06/03/08